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IBM CORP (YA)
C/O YEE & ASSOCIATES PC
P.O. BOX 802333
DALLAS, TX 75380

EXAMINER	
THERIAULT, STEVEN B	

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JANANI JANAKIRAMAN
and RABINDRANATH DUTTA

Appeal 2008-0998
Application 09/842,835
Technology Center 2100

Decided: May 6, 2009

Before MICHAEL R. FLEMING, *Chief Administrative Patent Judge*, JAMES T. MOORE, *Vice Chief Administrative Patent Judge*, JAMES D. THOMAS, JEAN R. HOMERE, and STEPHEN C. SIU, *Administrative Patent Judges*.

SIU, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

Appellants request reconsideration of our decision to affirm the Examiner's implied rejection of claims 1, 2, 3, 6-10, 13-17, 20, 21, 22, 24-

26, and 28-33 under 35 U.S.C. § 103(a). (Decision mailed February 4, 2009).[1]

SUMMARY OF THE ORIGINAL DECISION

The claimed subject matter on appeal involves rendering graphical information in textual form. In particular, independent claim 1 recites analyzing a set of graphical data to determine a set of critical factors, ranking the determined critical factors according to respective priorities, and generating a textual description of the set of graphical data, ordered according to the priorities (Decision 2). Claim 4 depends from claim 1, and additionally recites that the textual description is presented in aural format.

The Examiner rejected claims 1-3, 6-10, 13-17, 20-22, 24-26, and 28-33 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,876,981 B1 ("Berckmans") and claims 4, 5, 11, 12, 18, 19, and 23 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Berckmans, and Wendy Chisholm et al., *Web Content Accessibility Guidelines 1.0*, W3C, Recommendation (1991) ("W3C"). (Decision 3.)

The Appellants treated claims 1, 3, 6-8, 10, 13-15, 17, 20-22, 24-26, and 28-33 as one group which stand or fall together (Decision 13-14). As such, we considered claims 1, 3, 6-8, 10, 13-15, 17, 20-22, 24-26, and 28-33

[1] Appellants do not request reconsideration as to claims 4, 5, 11, 12, 18, 19, 23, and 27.

as one single group and selected independent claim 1 as the representative claim of the group (Decision 14).

We reversed the Examiner's rejection of claims 1-3, 6-10, 13-17, 20-22, 24-26, and 28-33 under 35 U.S.C. § 102(e) (Decision 9-10). However, we affirmed the Examiner's rejection of dependent claim 4, which depends from claim 1, under 35 U.S.C. § 103(a) as being unpatentable over the combination of Berckmans and W3C.

Because the narrower claim 4 depends from the broader claim 1 and because we affirmed the Examiner's rejection of claim 4 under 35 U.S.C. § 103(a) over the cited references, we further found claim 1 (a broader claim from which claim 4 depends) to also be unpatentable under 35 U.S.C. § 103(a) (Decision 3, 13, and 14).

In affirming claim 1, we relied upon *Ormco Corp. v. Align Technology, Inc.*, 498 F.3d 1307, 1309-20 (Fed. Cir 2007). In *Ormco Corp*, the Court held that when dependent claims "were found to have been obvious, the broader claims . . . must also have been obvious." In *Ormco*, "[dependent] claims 10 and 17 . . . were invalid as obvious" but independent claims 1 and 11 from which claims 10 and 17 depended, had not been determined to be obvious. The Court reasoned that "[b]ecause claims 10 and 17 were found to have been obvious, the broader claims 1 and 11 must also have been obvious" (*Ormco* at 1319).

THE REQUEST FOR REHEARING

Appellants contend that our Decision on Appeal mailed February 4, 2009 was erroneous because "[c]laims 2, 3, 6-10, 13-14, 16, 17, 20, 21, 24-26 and 28-33 were not rejected by the Examiner under 35 U.S.C. § 103 (and therefore the affirmance of a non-existent, phantom rejection of these claims under 35 U.S.C. § 103 is error)" (Req. Reh'g 2). Appellants further assert that "Appellants have had no opportunity to rebut any obviousness assertion with respect to such claims – which is a violation of due process and fundamental fairness" (Req. Reh'g 4).

However, the Appellants' request for rehearing did *not* raise a challenge to the merits of our reliance upon the *Ormco Corp* in affirming claim 1.

ISSUE

Thus, the issue before us is whether Appellants' independent claim 1 is unpatentable over the combination of Berckmans and W3C by virtue of its dependent claim 4 being unpatentable over the same combination?

ANALYSIS

In filing the Request for Rehearing, Appellants had the opportunity and obligation to "state with particularity the points believed to have been misapprehended or overlooked by the Board." 37 C.F.C. § 41.52(a).

The Appellants do not argue the merits of the rejection of any of claims 1-33, as explained by the Board. Nor do Appellants contend that the Board "misapprehended or overlooked" any points relating to the merits of the rejection of the cited claims. See 37 C.F.R. § 41.52(a)(1). Instead, Appellants request to be afforded the procedural options available under 37 C.F.R. § 41.50(b)(1) for responding to the alleged new ground of rejection. (Req. for Reh'g 4-5).

The affirmance of a conclusion of obviousness of an independent claim may be made when based on a prior determination of obviousness of a corresponding dependent claim. As the Court made clear in *Ormco*, when a dependent claim is "found to have been obvious . . . the broader claims . . . must also have been obvious" (*Ormco* at 1319).

In the Opinion, we affirmed the Examiner's rejection of dependent claim 4 as unpatentable under 35 U.S.C. § 103(a) over Berckmans and W3C, which Appellants do not contest. Because claim 4 includes all the limitations recited in claim 1, we concluded that claim 1 "must have been obvious" since claim 4 was found to be obvious. As such, we found that the Examiner's rejection of claim 4 under 35 U.S.C § 103 constitutes an implied obviousness rejection of corresponding independent claim 1.

There is no new ground of rejection when the basic thrust of the rejection remains the same such that an appellant has been given a fair opportunity to react to the rejection. See *In re Kronig*, 539 F.2d 1300, 1302-03 (CCPA 1976). Therefore, a rejection of claims 1-3, 6-10, 13-17, 20-22,

24-26, and 28-33 constitutes a new ground of rejection if the rationale for the rejection changes the "thrust" of a prior rejection.

Under the specific facts of this case, our interpretation of claim terms was not previously detailed by the Examiner. Further, our claim interpretation differs from the Examiner's and implicates different reasoning.

We conclude that this factual situation rises to the level where "the issues arising under the two sections may be vastly different, and may call for the production and introduction of quite different types of evidence" (*In re Hughes*, 345 F.2d 184, 185-186 (CCPA 1965)). In such situations involving a possible misunderstanding of a procedural matter, the Board, at its discretion, may follow an "abundance of fairness policy." See *Ex parte Letts*, 88 USPQ2d 1854, 1859 (BPAI 2008).

Therefore, in the circumstances of this case, we exercise discretion to grant the Appellants' request to designate the Decision's affirmance of the rejection of claims 1-3, 6-10, 13-17, 20-22, 24-26, and 28-33 under 35 U.S.C. § 103(a) as a new ground of rejection pursuant to 37 C.F.R. § 41.50(b).

This decision on rehearing does not constitute a new decision on appeal. Nor does it turn the original Decision into a new decision. Accordingly, pursuant to 37 C.F.R. § 41.52(a)(1), no request for rehearing from this decision on rehearing is permitted. Also, because Appellants did not argue in the rehearing request the merits of any rejection as explained by

the Board, Appellants are not entitled to any further relief under 37 C.F.R. § 41.50(b)(2) once the original decision has been modified to designate the affirmance of the obviousness rejection of claims 1-3, 6-10, 13-17, 20-22, 24-26, and 28-33 as a new ground of rejection.

CONCLUSION

The Appellants' Request for Rehearing is granted to the extent ordered below.

ORDER

The Board's affirmance of the rejection of claims 1-3, 6-10, 13-17, 20-22, 24-26, and 28-33 under 35 U.S.C. § 103(a) as unpatentable over Berckmans is designated as a new ground of rejection under 37 C.F.R § 41.50(b).

> Pursuant to the applicable sections of 37 C.F.R. § 41.50(b) the Appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise the following option with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

> (1) *Reopen prosecution*. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

GRANTED
37 C.F.R. § 41.50(b)

rwk

IBM CORP (YA)
C/O YEE & ASSOCIATES PC
P.O. BOX 802333
DALLAS, TX 75380